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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,023	11/30/2001	Aalim Lakhani	jCA920000045US1 (7161-185)	6797
46320	7590	06/08/2006	EXAMINER QUELER, ADAM M	
CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 1300 CORPORATE CENTER WAY SUITE 105G WELLINGTON, FL 33414			ART UNIT 2178	
DATE MAILED: 06/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,023

Applicant(s)

LAKHANI ET AL.

Examiner

Adam M. Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 15, 16 and 19-23 is/are rejected.
- 7) ☒ Claim(s) 20-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 03/10/2006, Response filed 5/9/2005, and IDS filed 05/02/2006.
2. Claims 1-23 are pending in the case. Claims 1-9, and 15-23 are elected. Claims 1 and 15 are elected independent claims.

Election/Restrictions

3. Claims 10-14 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/4/2005.

Information Disclosure Statement

4. The information disclosure statement filed 5/2/2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Reference F6 is provided in its entirety.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 9 and 19-23 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The claims recite "computer code." However, the specification defines computer code can be a "signal carried in a carrier". This is also shown at least by the limitations in claims 20-22, that

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the compute program product includes signals. This is not a statutory embodiment. it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

First, a claimed signal is clearly not a "process" under Sec. 101 because it is not a series of steps. The other three Sec. 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents Sec. 1.02 (1994). The three product classes have traditionally required physical structure or material.

"The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." *Corning v. Burden*, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See *American Disappearing Bed Co. v. Arnaelsteen*, 182 F. 324, 325 (9th Cir. 1910), cert. denied, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. *Lorillard v. Pons*, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in *American Fruit Growers* when it passed the 1952 Patent Act.

A manufacture is also defined as the residual class of product. 1 Chisum, Sec. 1.02[3] (citing W. Robinson, *The Law of Patents for Useful Inventions* 270 (1890)). A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of Sec. 101. As the claimed product encompasses signals as explained above, the claims are not limited to statutory embodiments and therefore are not statutory.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1, 4, 9, 15, 19-23 remain rejected under 35 U.S.C. 102(b) as being anticipated by Nazem (US005983227A, published 11/9/1999).**

Regarding independent claim(s) 1 and 15, Nazem teaches a receiving and passing the page request from the server (col. 3, line 59 – col. 4, line 2). Nazem teaches identifying and receiving a template for generating a page to be returned in response to the request. Nazem teaches that templates have identifiers (col. 3, ll. 35-48). Nazem teaches a set of templates (col. 3, ll. 26-29). Therefore Nazem also teaches a set of template identifiers. Nazem teaches associated template page attributes (col. 5, ll. 31-32). Nazem teaches matching default values when they are not determinable (col. 6, ll. 21-50).

Regarding dependent claim(s) 4, Nazem teaches a template editor (col. 3, ll. 24-26)

Regarding dependent claim(s) 9, 19-23, the embodiments of the claims dependent on claims 1, 4, and 15, respectively, are rejected under the same rationale.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 9, 16, 19-23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nazem.

Regarding dependent claim(s) 2 and 16, Nazem teaches a database (col. 3, ll. 40-41). Nazem does not explicitly teach a relational database. Official Notice is taken that relational databases accessible by queries were well known in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to use relational databases accessible by queries in order to retrieve the data (col. 3, ll. 15-20).

Regarding dependent claim(s) 9, 19-23, the embodiments of the claims dependent on claims 2 and 16, respectively, are rejected under the same rationale.

11. Claims 3, 5, and 9 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nazem as applied to claims 1 and 4 above, and further in view of “Java Server Pages,” found at <http://java.sun.com/products/jsp/> archived 11/9/2000.

Regarding dependent claim(s) 3, Nazem does not specifically disclose Java Server Pages. Sun teaches Java Server Pages (p. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Java Server Pages as they make it faster and easier to build applications (p.1).

Regarding dependent claim(s) 5, Nazem does not specifically disclose Java Server Pages. Sun teaches Java Server Pages (p. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to create Java Server Pages as they make it faster and easier to build applications (p.1).

Regarding dependent claim(s) 9, the embodiments of the claim dependent on claims 3 and 5 are rejected under the same rationale.

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12. Claims 6 and 9 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nazem as applied to claim 1 above, and further in view of Applicant's Admitted Prior Art.

Regarding dependent claim(s) 6, Nazem does not explicitly disclose generating the page by a consumer for a store. However, Applicant admits that generating a page for an electronic store was a known and desired in the art at the time of the invention (p.1. para. 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Nazem's technology for an online store since it was desirable (Applicant's Admitted Prior Art, p.1, para. 4) and to achieve the customization desired by users (Nazem, col. 1, ll. 22-23).

Regarding dependent claim(s) 9, the embodiment of the claim dependent on claim 6 is rejected under the same rationale.

Allowable Subject Matter

13. Claims 7-8 and 17-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 9, 19-23 are rejected as being dependent upon a rejected base claim, but would be allowable if rewritten to only include dependencies on allowable claims. Claims 9, 19, and 23 are also rejected under 35 U.S.C § 101, and must overcome that rejection before allowance.

Response to Arguments

15. Applicant's arguments filed 5/9/2005 have been fully considered but they are not persuasive.

Regarding Applicant's remarks on Allowable Subject Matter:

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Applicant requested clarification on the status of claims 9, 23, since the claims were listed as both rejected and allowable. This is the case because of their multiple dependencies. Some of the claims they dependent on are allowable (objected) while others are rejected, hence their dual status.

Regarding Applicant's remarks on § 101 rejections :

Please see the expanded rejection above.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In this case Applicant merely describes the prior art and the instant invention, and does not point out the differences. Applicant underlines a few elements, which allegedly have meaning, but those elements are specifically recited in the rejections above. It is not clear what Applicant is alleging the Nazem is lacking.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140.

The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ



STEPHEN HONG
SUPERVISORY PATENT EXAMINER